

## REMARKS

Claims 1-81 were pending in the present application. Claims 15-17, 23-40, 54-56, and 66-81 have been withdrawn from consideration. By virtue of this response, claims 1, 2, 6, 9, 14, 18, 20, 46, and 50 have been amended. New claims 82-94 have been added. No claims have been cancelled. Amendment and cancellation of certain of the claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

### *Summary of Interview*

On April 17, 2003 the undersigned had a telephonic interview with Examiner Bradford and Primary Examiner Evanisko to discuss the election/restriction requirement and to discuss U.S. Pat. No. 6,161,045 to Fischell, *et al.* ("Fischell"). The Examiners did not agree that the restriction/election requirement was improper. In addition, the Examiners did not agree that claim 1 fell outside the scope of Fischell's teachings. The Examiners provided suggestions for making claim amendments that would put the pending claims in condition for allowance. The Examiners' suggestions are considered in the above amendments and discussed in the below remarks.

### *Rejections under 35 U.S.C. § 102(e)*

#### Claims 1-7, 12, 18-21, 46, 50-53, 57 and 58

Claims 1-7, 12, 18-21, 46, 50-53, 57 and 58 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Fischell. Claims 1, 46, and 50 are the independent claims, from which the remaining rejected claims depend. With respect to claims 1 and 50, the Office Action asserts that, "Fischell discloses a method for treating abnormal neurological condition comprising, applying to brain tissue at least one electrical burst comprising a multiplicity of pulses and said pulse parameteres and varying at least one of the pulse parameters during at least one electrical burst (column 5, lines 29-39)." With respect to claim 46, the Office Action asserts,

“[r]eferring to claims 46 and 50, at least a first electrical electrode (column 7, line 19), and at least an electrical signal source, said first electrical signal source initiating a stimulation burst to said electrode, said burst having pulse parameters (column 7, lines 27-35), which the pulse parameters vary during said burst (column 5, lines 29-39).”

Claims 1, 46, and 50 have been amended to recite that the pulse parameter or parameters to be varied are determined prior to the application of the burst, and that the burst is applied prior to detecting electrical activity. As discussed during the above referenced telephonic interview, the Examiners argued that Applicant’s use of the term “burst” did not exclude the pulses of Fischell, because it was open-ended, having no durational or temporal limitation. The undersigned noted that Fischell requires an observation step during the burst, *see, e.g.*, FIG. 2 and Col. 5 lines 7-57. In this way, Fischell can modify the pulse parameters during the burst in response to any noted observations.

Applicant’s claims require selection of a pulse parameter for varying, prior to the initiation of a burst, the burst being applied prior to detection of electrical activity. As such, Fischell fails to teach or disclose each and every limitation of claims 1, 46, and 50 (from which the remaining claims depend).

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §102(e) over Fischell be withdrawn.

***Rejections under 35 U.S.C. § 103(a)***

**Claims 8, 10 and 11**

Claims 8, 10 and 11 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fischell. Claims 8, 10, and 11 depend from claim 1, which was discussed in detail above. Because each and every element of claim 1 has not been established, each and every element of claims 8, 10, and 11 have not been established. Additionally, no reason to modify the procedure shown in Fishcell has been provided with the Office Action. Therefore,

the Office Action fails to set forth even a *prima facie* case of obviousness with respect to these claims.

Accordingly, the Applicant respectfully request that the rejections of claims 8, 10, and 11 under 35 U.S.C. § 103(a) be withdrawn.

#### Claim 9

Claim 9 stands rejected under 35 U.S.C. §103(a) over Fischell, in view of U.S. Pat. No. 5,792,212 to Weijand *et al.* (“Weijand”). Claim 9 depends from claim 7, which in turn depends from claim 1. As discussed above, Fischell fails to teach each and every element of claim 1. Namely, Fischell fails to teach the determination of a pulse parameter to vary, prior to initiation of an electrical burst. Weijand fails to cure this deficiency. As Applicant explained in the previous response to Office Action, Weijand fails to make any suggestion or show any need for varying a pulse parameter during a burst.

Applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. § 103(a) be withdrawn.

#### Claim 13

Claim 13 stands rejected under 35 U.S.C. §103(a) over Fischell, in view of U.S. Pat. No. 5,713,923 to Ward *et al.* (“Ward”). Claim 13 depends from claim 7, which in turn depends from claim 1. Claim 1 was discussed in detail in the sections above, where it was explained that Fischell fails to teach each and every element of that claim. Ward fails to cure this deficiency. Ward makes no suggestion of varying a pulse parameter during a burst, where the determination of the pulse parameter to be varied is made prior to the initiation of an electrical burst.

Therefore, Applicant respectfully requests that the rejection of claim 13 under 35 U.S.C. §103(a) be withdrawn.

***Allowable Subject Matter***

The Office Action notes that claims 22, 41-45, 59, and 62-65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for noting such allowable matter and has rewritten these claims in independent form and presented them as new claims 82-94.

## CONCLUSION


Applicant has, by way of the amendments and remarks presented herein addressed all issues that were raised in the outstanding Office Action. Applicant respectfully contends that this Amendment has overcome the rejections and that the pending claims are in condition for allowance. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **459992000700**.

Respectfully submitted,

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